



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/574,194	12/18/95	MILKS	R 7389-002-25

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EXAMINER

BURN, B

ART UNIT

PAPER NUMBER

1521

DATE MAILED:

08/13/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Payer

1-800-386-7784

Office Action Summary

Application No.
08/574,194

Applicant(s)
Milks

Examiner
Brian M. Burn

Group Art Unit
1621

☒ Responsive to communication(s) filed on 13 Jul 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-40 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-40 are pending in this application.

Claims 1-11 stand rejected on the grounds of estoppel for the reasons already of record. Applicant's remarks relative hereto have been given careful consideration, but are deemed non-persuasive. The judicial opinions cited in the previous office action represent controlling legal authority. Applicant has not addressed the holdings of these opinions, nor the applicability of these holdings to the present fact situation. The doctrine of *stare decisis* controls.

Claims 12-40 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. 5,177,107 for the reasons already of record. Applicant's remarks relative hereto have been given careful consideration, but are deemed non-persuasive.

Reading claim 14, for example, as broadly as the language permits, reveals a composition of matter *comprising* a solid food carrier and an insecticidally effective amount of an anionic fluorochemical surfactant which is insoluble in vegetable oil (although vegetable oil may still be present in the claimed composition). The patent discloses compositions of matter comprising a solid food carrier (col. 3, line 35) impregnated with an anionic fluorochemical surfactant which is insoluble in vegetable oil (col. 1, line 55; col. 9, compd. 29779).

Applicant has not indicated that none of the active ingredients in the patent are vegetable-oil insoluble. It is true that the patent doesn't appear to specifically indicate which active ingredients therein are vegetable oil insoluble. But it doesn't appear to matter; some of the same active ingredients of the application are, at the very least, generically disclosed by the patent.

Dispute {
Need a vegetable oil soluble

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Applicant is invited to amend the present claims so they are not open-ended (e.g., by deleting the term 'comprising' or 'comprises') and so that they specifically exclude all active ingredients disclosed in the patent. Also, in order to better delineate the claimed invention over the patent, Applicant may wish to consider specifically excluding vegetable oils from the claims. The present limitation that the active ingredient be vegetable oil insoluble is insufficient; active ingredients disclosed in the patent are vegetable oil insoluble.

The declaration (originally filed in 07/142,525) has been given careful consideration, but is deemed non-persuasive. The portions of the declaration relied upon by Applicant suggest, in essence, that one of ordinary skill in the art would not look to otherwise known vegetable oil insoluble toxicants because they are insoluble in oil. This is a circular argument at best, but there is simply no comparison against the closest prior art. There is no evidence of unexpectedly superior toxicity in the form of a side-by-side comparison in this declaration. In short, the declaration has been carefully considered, but Applicant has not met his burden in overcoming the established case of *prima facie* obviousness.

Example 4 in the Milks patent has been given careful consideration, but is deemed non-persuasive. It is noted that the inventive composition contains 1% FC-95, 95% dried yellow cornmeal, and 4% soybean oil. This appears to indicate that Applicant recognized that all the fluorosurfactants disclosed in the Meer patent to be insecticidal will work effectively; but Applicant has discovered that some of the fluorochemical surfactants in the Meer patent are vegetable oil insoluble. But that they are insecticidal, too. A better prior art comparison would

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have been to compare a composition containing 1% FC-95, 95% dried yellow cornmeal, and 4% soybean oil, against a composition containing 1% vegetable oil soluble fluorochemical surfactant, 95% dried yellow cornmeal, and 4% soybean oil.

In any respect, motivation to make the instant invention may be found in the patent. At example 3 therein, Meer states that many oil-insoluble compounds may be highly effective in other compositions. This statement adds to the requisite motivation to make the claimed invention.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian M. Burn whose telephone number is (703) 308-4525.

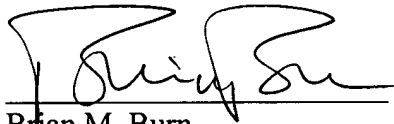
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The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "Brian M. Burn", written over a horizontal line.

Brian M. Burn
Primary Examiner
Group 1621